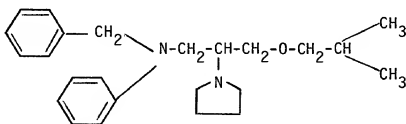


4. Since new facts and reasons, in compliance with a decision of the Patent and Trademark Office Board of Appeals which is dispositive of the issues raised, which would place this application in condition for allowance have been presented, entry of the Declaration Under 37 CFR 1.132 and the Response is appropriate, see MPEP 706.07(e).

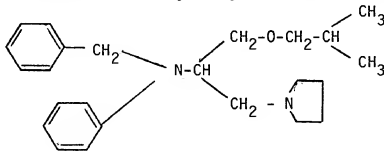
REMARKS

Claims 7 and 8 remain in this application. Reconsideration is respectfully requested.

This application is a reissue application. Reissue is necessitated by the discovery that the structure of compound I of the present invention, resulting from the reaction of 1-(3-isobutoxy-2-chloro) propyl pyrrolidine and N-benzylaniline results in a compound of the following structure:

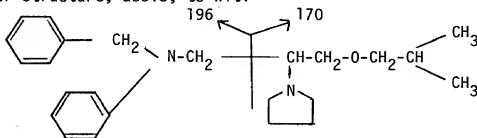


rather than the structure originally disclosed, to wit:

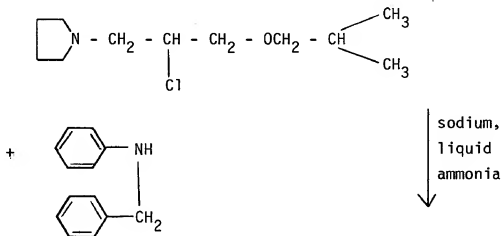


While the molecular weight of compounds of both structures, above, based on the empirical formula $C_{24}H_{34}N_2O$ is the same, the mass spectral analysis of the compound, shows a weak molecular ion at m/e of 366.2620 (confirming the molecular formula) but, significantly, also shows fragments at m/e 196

($C_{14}H_{14}N$) and m/e 170 ($C_{10}H_{20}NO$). These fragments can only arise from the former structure, above, to wit:



The discovery of this error came about after issuance of U.S. Patent 3,962,238, when a third party conducting additional testing on the above-noted compound raised a question as to ambiguity in the synthesis route. In other words, based on the reaction involving an immonium ion intermediate, there was a possibility of two products being formed depending on the site of bond cleavage, as illustrated in the following reaction scheme:



inherent product of the synthesis disclosed.

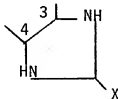
Claims 7 and 8 are rejected under 35 USC 251 as being unpatentable for various reasons. These grounds for rejection are respectfully traversed.

First, the Examiner contends that new matter has been introduced into the specification and claims by virtue of the change of the structural formula.

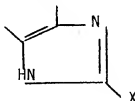
The Examiner's attention is directed to the unpublished decision of the Patent and Trademark Office Board of Appeals, Ex parte Marsili et al, Appeal No. 378-66, decision dated September 27, 1979, a copy of which is enclosed. This decision is directly in point since it considered the question of whether it was new matter to change the structural formula for the claimed product in the specification and claim. The Board of Appeals found that such a change was not new matter under 35 USC 132 and, in fact, readily approved such a correction, at page 7, stating:

"To refuse correction of the structural formula of Appellants' claimed compounds, which have been found patentable by the Examiner, would lead to the absurdity of issuing a patent which teaches the public in its specification the wrong scientific formula for the new products."

In particular, Marsili, was concerned with a claim to a novel Rifamycin wherein the specification and claims indicated the following imidazoline ring across the 3,4-position of the Rifamycin-SV type structure



as originally filed. Further, more refined, analytic investigation showed that the ring in fact was the imidazole ring, which is the stable aromatic structure:



Appellants, in Marsili, having submitted a showing under 37 CFR 1.132 to support the propriety of the change and to show that the proposed structure was an inherent characteristic of the claimed compounds, were held not to have introduced new matter.

In this regard, Applicants are herewith submitting a Declaration Under 37 CFR 1.132 which shows not only the genesis of the discovery of the error but also shows the inherency of the now amended structure for the compound I of this invention. In this regard, the Examiner's attention is directed to Exhibits C and D wherein independent investigation by Wallace Laboratories confirms that a rearrangement occurs in the last step of forming compound I of this application rather than a simple displacement of the chlorine atom. Additionally, Exhibit B shows a comparison done by the University of Paris as between the product produced by Applicants' process and an unambiguous synthesis of a compound of the formula as now amended. This comparison established that the two samples were one and the same compound. Finally, in Exhibit F, another study by the University of Paris establishes that the structures of additional compounds disclosed in this specification are consistent with that of compound I, as amended, i.e., produced by the rearrangement in the last reaction step.

Accordingly, it is submitted that Applicants have established the inherency of the structural formula of compound I, as now amended, and, as such, have overcome this ground for rejection.

Second, Applicants have submitted herewith a Supplemental Reissue Declaration in full compliance with 37 CFR 1.175. In particular, the Supplemental Reissue Declaration clearly sets forth Applicants' belief that the original patent is wholly or partly inoperative by reason of a defective specification due to the original misconception of the structural formula of compound I. Furthermore, Applicants clearly set forth the facts as to how this error arose and occurred. Additionally, the

Examiner's attention is directed to the above-noted Declaration Under 37 CFR 1.132 for factual corroboration as to how the error arose or occurred. In particular, see Exhibit E.

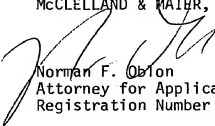
Finally, the claims as now amended do not enlarge the scope of the original claims, but, rather only give the correct structural formula for compound I. As was quoted in the Marsili case (Petisi et al v. Rennhard et al, 53 CCPA 1452 (CCPA 1966) at 1457):

"The product, not the formula or name, is the invention."

Accordingly, this application is now deemed to be in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

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